

12 for recording telephone conversations between two parties, i.e., Party 13 and Party 14. Party 13 and Party 14 connect to the audio vault 12 via telephone lines, a computer network or the Internet. According to one embodiment, a first party establishes a connection to the audio vault by placing a telephone call, and a connection with a second party is established either by the audio vault placing a call to the second party or the second party placing a call to the audio vault (See column 6, lines 19-39 of Walker).

Harman discloses a method and apparatus for storing voice messages in a communication package. The communication package includes a voice chip enclosed in a storage disc, and a renewable, battery power system for operating the voice chip. Harman further discloses an interface for recording and downloading sound messages to the communication package.

It is well known that in order to support a rejection under 35 U.S.C. §103(a), the Office Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some motivation to combine or modify the applied references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-3 and 5-16 are not rendered unpatentable in view of the combination of Walker and Harman because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

In rejecting claims 1, 5, 8 and 14, the Examiner asserts that it would have been obvious to one skilled in the art to modify the system of Walker to include sending a message requesting authorization for the recording from a first

telecommunications device to a second telecommunications device as allegedly taught by Harman so that the modified system of Walker "would be able to support a first telecommunication device equipped with a recording system so that the message for authorization of recording can be sent from the first telecommunication device to the system users."

As discussed in section 2143.01 of the MPEP, the fact that references can be combined is not sufficient to establish *prima facie* obviousness. MPEP section 2143.01 states:

[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Emphasis in original.

However, nowhere in Walker is there any disclosure or suggestion of providing a telecommunications device equipped with a recording device as suggested by the Examiner. Furthermore, the Examiner fails to provide any evidence that one skilled in the art would have desired such a modification. To the contrary, the Examiner merely asserts that it would have been obvious to modify the system of Walker to include sending the message from the first telecommunications device. Accordingly, absent proper motivation to modify the teachings of Walker to include the teachings of Harman, the rejection of claims 1-3 and 5- 16 is improper.

Furthermore, even if, *arguendo*, one skilled in the art were motivated to combine Walker and Harman, the combination would still fail to render claims 1-3 and 5-16 unpatentable for at least the reason that the combination fails to disclose each and every claimed element as discussed below.

Independent claim 1 defines a method of recording a telephone conversation between first and second telecommunications devices, wherein the recording is performed under the control of the first telecommunications device. The method includes, *inter alia*, the steps of: sending from said first telecommunications device to said second telecommunications device a message requesting authorization for the recording of the telephone conversation; and performing the recording only if a responding message giving authorization is received and recognized by the first telecommunications device in response to the requesting message. Furthermore, both of the telecommunication devices include a speaker and a microphone.

In rejecting claim 1, the Examiner makes several conflicting assertions and then appears to conclude that it would have been obvious to modify the system of Walker to include sending a message from the first telecommunications device as allegedly taught by Harman. This assertion is unfounded for the following reason.

① Nowhere in Harman is there any disclosure or suggestion of sending a message requesting authorization for the recording from a first communication device to a second communication device. Therefore, even if one skilled in the art were motivated to combine the unit interface disclosed in Harman with the vault recording/storage system of Walker, the combination would still fail to render claim 1 unpatentable for at least the reason that the combination fails to disclose or suggest sending a message requesting authorization for the recording from the first telecommunications device to the second telecommunications device as claimed.

At best the combination of Walker and Harman teaches a system for recording and storing messages in a vault and/or storing messages in a communications package. However, nowhere in either reference is there any

discussion or disclosure of sending a message as claimed. Accordingly, independent claim 1 is not rendered unpatentable over the combination of Walker and Harman.

④

Independent claim 2 defines a method of prohibiting the recording of a telephone conversation between first and second telecommunications devices. The method includes, *inter alia*, sending from the first telecommunications device to the second telecommunications device a message requesting authorization for the recording of the telephone conversation. Accordingly, claim 2 is patentably distinguishable over the combination of Walker and Harman for at least the reason that the combination fails to disclose or suggest sending an authorization message from the first telecommunications device as recited in claim 2. (See discussion above with respect to claim 1).

⑤

Independent claim 8 defines a telecommunications device for performing telephone conversation with other telecommunications devices. The telecommunications device is configured to send to another telecommunications device a message requesting authorization to record the telephone conversation. Furthermore, independent claim 13 defines a telecommunications device configured to automatically respond to a received message requesting authorization to record a telephone conversation. Accordingly, claims 8 and 13 are patentably distinguishable over the combination of Walker and Harman for at least the reason that the combination fails to disclose or suggest sending or responding to the authorization message as recited in claims 8 and 13. (See discussion above with respect to claim 1).

④ Independent claim 14 defines an electronic accessory device. The device is configured to connect to a telecommunications device for performing telephone conversations with other telecommunications devices, and to record the telephone conversation between two telecommunications devices. Furthermore, the device is configured to instruct the telecommunications device to which it is connected to send a message requesting authorization to record a telephone conversation to another telecommunication device. According, claim 14 is patentably distinguishable over the combination of Walker and Harman for at least the reason that the combination fails to disclose or suggest an electronic accessory device configured to instruct a telecommunications device to which is connected to send an authorization message as claimed.

④ Claims 3, 5-7, 9-12, 15 and 16 variously depend from independent claims 1, 8 and 14. Therefore, claims 3, 5-7, 9-12, 15 and 16 are patentably distinguishable over the combination of Walker and Harman for at least those reasons presented above with respect to claims 1, 8 and 14.

For at least those reasons presented above Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3 and 5-16 under 35 U.S.C. §103(a).

④ In paragraph 3, the Examiner rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Walker in view of Harman, further in view of U.S. Patent No. 6,278,884 to Kim ("Kim") and U.S. Patent No. 6,526,287 to Lee ("Lee"). Applicants respectfully traverse this rejection.

Independent claim 4 defines a method of recording information exchanged between first and second telecommunications devices, said recording being

performed under control of said first telecommunications device. The method includes, *inter alia*, the steps of sending from the first telecommunications device to the second telecommunications device a message requesting authorization for the recording; sending a responding message giving authorization from said second telecommunications device; and performing said recording, by circuits integrated in the first telecommunications device or by an accessory attached to the first telecommunications device, only if said responding message giving said authorization is received and recognized by said first telecommunications device.

The combination of Walker and Harman discloses a system for recording and storing messages in a vault and/or storing messages in a communications package. Kim discloses a multi-function portable cellular phone modified to incorporate features which provided a lightweight security system. According to a first embodiment, the cellular phone is modified to incorporate an alarm, image capture and audio capture functions in the same housing. Lee discloses a cellular phone capable over accommodating electronic devices such as an MP3 player or hands-free device. Accordingly, the combination of Walker, Harman, Kim and Lee discloses a system of recording and storing voices messages between two cellular phones, wherein said cellular phones are capable of capturing image and/or audio information with or without an electronic accessory. However, the combination fails to render claim 4 unpatentable for at least the reason that the combination fails to disclose or suggest each and every claimed element.

Nowhere in the combination of Walker, Harman, Kim and Lee is there any disclosure or suggestion of sending an authorization message from the first

telecommunications device to the second as recited in claim 4. Accordingly, the combination of Walker, Harman, Kim and Lee fails to render claim 4 unpatentable.

Furthermore, the Examiner fails to provide proper motivation for the combination of Walker, Harman, Kim and Lee. As discussed above, the mere fact the references can be combined is not sufficient to render the resultant combination obvious unless the prior art also suggests the desirability of the combination/modification. (See discussion above) Accordingly, absent proper motivation to combine Walker, Harman, Kim and Lee, the rejection of claim 4 is improper.

For at least those reasons presented above Applicants respectfully request reconsideration and withdrawal of the rejection of claim 4 under 35 U.S.C. §103(a).

The application is in condition for allowance. Notice of same is earnestly solicited. Should the Examiner have any questions regarding this application, the examiner

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: April 19, 2003

By:



Penny L. Caudle

Registration No. 46,607

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620